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09/891,774	06/26/2001	James E. Black JR.	70255	2703

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EXAMINER

BARTZ, CLIFFORD T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,774

Applicant(s)

BLACK

Examiner

C. Bartz

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/12/02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) 31-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 34-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### Part III DETAILED ACTION

#### Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim(s) 1 – 10, 34 – 36, 41 – 43 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim(s) 1 – 10, 11 – 13, 14 – 16, respectively; of prior U.S. Patent No. 5, 765, 486. This is a double patenting rejection.

#### Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 - 30, 34 - 44 drawn to railroad car door structure, classified in Class 105, subclass 375.

II. Claim 31 - 33, drawn to roof coatings, classified in Class 105, subclass 396.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as being capable of being used in a shed roof. See M.P.E.P. § 806.05(d).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Claim(s) 31 - 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

#### Specification

The abstract of the disclosure is objected to because it is identical to the abstract of the parent case patent number 5,765,486. Correction is required. See MPEP § 608.01(b).

#### Claim Objections

Claim(s) 37 is(are) objected to in that in line 6, the 5th word should be changed from "being" to -- between --.

#### Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim(s) 1 - 6 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by Blunden.

Blunden discloses a roof A2 in Fig. 1 used for covering the lower level of cars; top portion 48 which extends ( to the same extent as applicant ) approximately from the centerline of the car ( note that the ends of claims 5, 6 are functional statements which do not limit the structure of the car ).

Claim(s) 11, 12 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by Paulyson.

Paulyson discloses vertical posts 26.

Claim(s) 19 - 23 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by Bruder.

Bruder discloses door edge protection strips 112 and 106 as affixed together ( see Figs. 6, 7 ).

Claim(s) 25 - 26, 29 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by Adams.

Adams discloses flexible enclosure 29; roof member 24; floor portions 3.

Claim(s) 41, 42 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by Baker.

Baker discloses roller 42 in Figs. 8, 9.

#### Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim(s) 13, 14 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Paulyson.

Paulyson discloses all the structure of the claimed device as detailed above; except for an outwardly opening channel and plate edges attached to flanges. It would have been an obvious matter of design choice dependent on cost and appropriate manufacturing facilities to orient the channels and plates of Paulyson so that the channels would be outwardly opening and the plate edges would be attached to flanges in order to reduce manufacturing costs. It is maintained that in such an arrangement as Paulyson, the configuration of the channels and plates with respect to other disclosed structure is well within the capability of a routineer in the art.

Claim(s) 15 - 18, 24, 44 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Bruder.

Bruder discloses all the structure of the claimed device including perforations ( col. 1, line 45 ); except for perforations being concentrated at predetermined areas heightwise and lengthwise in the side walls, such perforations having particular configurations and sizes; and elongated slots to accommodate fasteners. It would have been an obvious matter of design choice dependent on such factors as: appearance and increased visibility within the car; to have the perforations concentrated at predetermined areas heightwise and lengthwise in the side walls. It would have been further obvious to one having ordinary skill in the art at the time the

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invention was made to have perforations with particular configurations and sizes; and elongated slots to accommodate fasteners since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It is maintained that in such an arrangement as Bruder, the particular configurations of perforations is well within the capability of a routineer in the art.

Claim(s) 27, 28, 30 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Adams.

Adams discloses all the structure of the claimed device as detailed above, and including 29 disclosed as pleated; except for roof members disclosed as pleated by an oriented mesh imbedded in a polymer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use roof members disclosed as pleated by an oriented mesh imbedded in a polymer, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim(s) 34 - 36 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Grommier ( Fig. 4 ).

Grommier discloses all the structure of the claimed device including door 19; flexible closure members 15; except for flexible closure members 15 attached to a door. It would have been an obvious expedient to one having ordinary skill in the art at the time the invention was made to have provided the door of Grommier with an attachment to 15b in order to keep the door 19 from opening beyond a desired amount. It is maintained that in such an arrangement as

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Gommier, determination of the appropriate characteristics of the contact between 19 and 15b is well within the capability of a routineer in the art.

Claim(s) 37 - 40 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Yulkowski.

Yulkowski discloses all the structure of the claimed device including flexible inner edge seal member 110, flange 104, opposite seal member 62; except for the use of Yulkowski in a railroad car door. To have utilized the specifics as disclosed in Yulkowski within the structure of a railroad car door would have been obvious to one having ordinary skill in the art at the time the invention was made, since any door structure may be used to achieve the intended function of the recited specific sealing structure.

Claim(s) 43 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Baker.

Baker discloses all the structure of the claimed device as detailed above; except for a track having an inverted L-shaped cross section. It would have been an obvious matter of design choice dependent on efficiency and cost to use an inverted L-shaped cross section. It is maintained that in such an arrangement as Baker, the determination of the specific characteristics of a track is well within the capability of a routineer in the art

Claim(s) 7, 8 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Blunden in view of Gommier.

Blunden discloses all the structure of the claimed device as detailed above; except for flexible closure members attached to a door. Gommier is relied upon merely to show that it is known in the art to provide flexible closure members 15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the doors of



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Blunden with flexible closure members like that of Gommier, in order to prevent dirt from getting into the railroad car.

Claim(s) 9, 10 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Blunden in view of Yulkowski.

Blunden discloses all the structure of the claimed device as detailed above; for except for seal members. Yulkowski is relied upon merely to show that it is known in the art to provide seal members 110. To have utilized the specifics as disclosed in Yulkowski within the structure of Blunden would have been obvious to one having ordinary skill in the art at the time the invention was made, since any door structure may be used to achieve the intended function.

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Bartz whose telephone number is (703)308 - 2564. The examiner can normally be reached on Mondays thru Fridays from 8:30 am to 3:30 pm.

( clifford.bartz@uspto.gov ) [ Fax -(703)308 - 3519 ]

If attempts to reach the examiner by telephone are unsuccessful; a message may be left at the Group Receptionist, whose telephone number is ( 703 ) 308 - 1113 .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavendar, can be reached on (703)308-3421

Any further inquiry of a general nature or relating to the status of this application may also be directed to the Group Receptionist, whose telephone number is ( 703 ) 308 - 1113.


Clifford T. Bartz  
Examiner

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CTB  
3/25/02

#### Summary:

Total claims	= 1 - 44
Withdrawn from consideration	= 31 - 33
Rejected claims	= 1 - 30, 34 - 44

  
JACK LAVINDER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

4/3/02